

REMARKS

Claims 1, 3, 7, 9-12, 25, 30-32 and new claims 33-34 are currently pending in the application, as amended. Claims 6, 13, 24 and 26-29 have been cancelled without prejudice. Claim 1 has been amended to clarify that the rail has pairs of first and second apertures extending through a wall and each picket passes through the rail and ending outside of the rail. Support for the amendment to claim 1 can be found in at least paragraphs [0036] of the published application and Figs. 2, 3, 5 and 6a-6b. Claim 7 has been amended to clarify that each picket passes through and is received by a corresponding holding aperture in the internal wall and a portion of each picket located inside of the rail between the entry and holding apertures is compressed partially radially inwardly. Support for the amendment to claim 7 can be found in at least paragraphs [0036] and [0041] of the published application and Figs. 6a and 6b. Claim 11 has been amended to clarify that the internal wall is moveable within the rail prior to insertion of the pickets through the entry and exit apertures and the apertures in the internal wall. Support for the amendment to claim 11 can be found in at least paragraph [0042] of the published application and Figs. 7b-7d. Claim 12 has been amended to clarify that the flanges receive and hold portions of the pickets. Support for the amendment to claim 11 can be found in at least paragraph [0041] of the published application and Fig. 6c. Claim 30 has been amended to remove functional language and to correct an antecedent basis error caused by the amendment to claim 1 from which claim 30 depends. Claim 32 has been amended to correct an antecedent basis error caused by the amendment to claim 1 from which claim 32 depends. New claims 33 and 34 have been added. Support for new claims 33 and 34 can be found in at least paragraphs [0038] and [0039] and Fig. 4b. Paragraph [0041] of the published application has been amended to include reference numbers that were inadvertently omitted. Support for the amendment to paragraph [0041] can be found in at least Figs. 6c and 6d. Accordingly, no new matter has been added.

Objection to the Drawings

1. The Examiner has objected to the drawings for including reference numbers not found in the description. Specifically, the Examiner asserts that reference numbers 66 and 67 of Figs. 6c and 6d are not found in the description. Number 66 in Fig. 6c refers to the flange and number 67 in Fig. 6d refers to the fixtures as described in paragraph [0041]. Paragraph [0041] has been

amended to include the omitted reference numbers 66 and 67. In view of the above amendment, it is respectfully requested that the objection to the drawings be withdrawn.

Claim Rejections – 35 U.S.C. § 102

2. The Examiner has rejected claims 1, 3, 6, 7, 9, 12, 13, 25-28 and 30-32 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,382,001 (Lichti). Claims 6, 13 and 26-29 have been cancelled. This rejection as it pertains to amended claims 1, 3, 7, 9, 12, 25 and 30-32 is respectfully traversed.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also MPEP § 2131.

Amended claim 1 of the present application is directed to a panel for a fence and recites:

at least one hollow rail having pairs of first and second apertures extending through a wall; and

a plurality of pickets supported by the rail, each picket passing through a first and second aperture pair, thereby passing through the rail and ending outside of the rail, the first aperture being spaced from the second aperture, a portion of each picket located inside of the rail between the first and second apertures being compressed partially radially inwardly within the rail in first and second converging directions thereby expanding the portion of each picket located inside of the rail partially radially outwardly within the rail in third and fourth diverging directions to thereby prevent further passage of each picket through the first and second apertures. [Underlining added for emphasis]

Applicant respectfully submits that Lichti does not disclose or suggest each and every element of amended claim 1. Specifically, Lichti does not disclose or suggest pairs of first and second apertures extending through a wall in the rail where each picket passes through a first and second aperture pair thereby passing through the rail and ending outside of the rail and the portion of each picket within the rail being compressed radially inwardly. Referring to Fig. 8, Lichti discloses a picket 68 that is inserted through a single aperture and does not extend entirely through the rail 69. Referring to Fig. 13, Lichti discloses an internal wall 113 such that the

picket 68 extends through two apertures but does not extend through and end outside of the rail and the portion of the picket inside of the rail is not compressed radially inwardly. Accordingly, Lichti fails to disclose each and every element of claim 1 of the present application.

The Examiner asserts on page 8 of the Office Action, in the rejection of claims 24 and 29, that extending the picket in Lichti entirely through the rail is obvious and has taken official notice that such a configuration is well known in the art. In accordance with MPEP § 2144.03(C), Applicant respectfully submits that it is not notoriously old and well known to proceed through extend the picket entirely through the rail because Applicants are not aware of any specific prior art references that teach this configuration in conjunction with the subject matter of amended claim 1. Thus, Applicants respectfully request that the Examiner provide a reference, in combination with Lichti, that teaches the specific structure of claim 1 and provides motivation to combine such teachings of Lichti.

However, Applicant respectfully submits that even if Lichti were modified to have an exit aperture, the picket within the rail in Lichti would not be radially compressed such that it would be held within the rail. Even if an exit aperture in Lichti were formed such that it partially compressed the picket as it was forced through the exit aperture, the compressed area would not prevent the picket from further extension through the exit aperture. Referring to Fig. 8, if the portion in the rail closest to number 88 were made to be an exit aperture, the picket would pass entirely through the rail 69 but the picket would not be compressed radially inwardly such that the picket would be prevented from passing further through the rail. The picket in such a modified Lichti device would continue to pass through the entry and exit apertures until the band 92 contacted the exit aperture. Referring to column 6, lines 34-35 in Lichti, the engagement of the end edge of the picket with the shaping grove 88 limits the penetration of the picket through the rail and therefore teaches away from extending the picket entirely through the rail.

Claims 3, 25 and 30-32 depend on amended claim 1 and are patentable over Lichti for at least the same reason discussed above and further due to the additional features that they recite. Based upon the above, Applicant respectfully requests that the Examiner reconsider and withdraw any rejection of claims 3, 25 and 30-32 based upon anticipation by Lichti.

Amended claim 7 of the present application is directed to a panel for a fence and recites:

at least one hollow rail;

a plurality of pickets supported by the rail, the rail having an external wall with entry apertures extending through the external wall for receiving the pickets; and

an internal wall, spaced internally from the external wall and the entry apertures and having a plurality of holding apertures,

wherein each picket enters the rail through a respective entry aperture and an end portion of each picket passes through and is received by a corresponding holding aperture in the internal wall, a portion of each picket located inside of the rail between the entry and holding apertures being compressed partially radially inwardly within the rail in first and second converging directions thereby expanding the portion of each picket located inside of the rail partially radially outwardly within the rail in third and fourth diverging directions such that a portion of the picket is held between the respective entry aperture and the corresponding holding aperture. [Underlining added for emphasis]

Applicant respectfully submits that Lichti does not disclose or suggest each and every element of amended claim 1. Specifically, Lichti does not disclose or suggest an internal wall, spaced internally from the external wall and the entry apertures and a picket extending through an entry aperture in the external and through a holding aperture in the internal wall where the portion of the picket between the entry aperture and the holding aperture is compressed radially inwardly. Referring to Fig. 8, Lichti does not disclose an internal wall. Referring to Fig. 13, Lichti discloses an internal wall 113 such that the picket 68 extends through entry and holding apertures but does not disclose that the portion of the picket between the entry and holding aperture be compressed radially inwardly. In Lichti, bands 116, 117 hold the picket 68 within the rail 109. Accordingly, Lichti fails to disclose each and every element of amended claim 7 of the present application.

Claims 9 and 12 depend on amended claim 7 and are patentable over Lichti for at least the same reason discussed above and further due to the additional features that they recite. Claims 6, 13 and 26-29 have been cancelled, rendering their rejections moot. Based upon the above, Applicant respectfully requests that the Examiner reconsider and withdraw any rejection of claims 7, 9 and 12 based upon anticipation by Lichti.

Claim Rejections – 35 U.S.C. § 103

3. The Examiner has rejected claims 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Lichti in view of U.S. Patent No. 2,590,929 (Bush). The Examiner asserts that Lichti discloses every element of claims 10 and 11 except for the holding apertures being offset with respect to the entry apertures. The Examiner asserts that such a configuration would have been obvious in view of the offset apertures disclosed in Bush. Claims 10 and 11 depend from amended claim 7 and are patentable over Lichti in view of Bush for at least the same reason discussed above in the section numbered “2” for the patentability of claim 7 over Lichti. Bush does not make up for the above noted deficiencies of Lichti. Specifically, Bush does not disclose compressing the pickets radially inwardly between the entry and holding apertures. Accordingly, Applicant respectfully requests that the rejection of claims 10 and 11 be reconsidered and withdrawn.

4. The Examiner has rejected claims 24 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Lichti. Claims 24 and 29 have been cancelled rendering their rejections moot.

New claims

New claims 33 and 34 have been added. News claims 33 and 34 are patentable over the cited references because none of the cited references disclose a rod that extends through each hole in each of the pickets between an internal wall and an external wall of a rail such that each picket is held within the rail.

CONCLUSION

In view of the foregoing Amendment and remarks, Applicant respectfully submits that the present application, including claims 1, 3, 7, 9-12, 25, 30-34, as amended, is in condition for allowance and such action is respectfully requested.

Respectfully submitted,

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